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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,450	09/20/2001	Gary Bultman	5589-02306	2573
35617	7590	03/22/2004	EXAMINER	
CONLEY ROSE, P.C. P.O. BOX 684908 AUSTIN, TX 78768			LEE, CALVIN	
			ART UNIT	PAPER NUMBER
			2825	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/957,450

Applicant(s)

BULTMAN ET AL.

Examiner

Lee Calvin

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/20/02.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1793-1872, 1949, 2041, 2057 and 2093 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1793-1872, 1949, 2041, 2057 and 2093 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

OFFICE ACTION

Election/Restriction

1. Claims 1793-1872, 1949, 2041, 2057, and 2093 are pending in this application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

(I) Claims 1793-1871 and 2057, drawn to a system configured to determine two properties of a specimen during use, classified in class 702, subclass 155.

(II) Claims 1872, 1949, 2041, and 2093, drawn to a method for determining two properties of a specimen, classified in class 438, subclass 14.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as a system configured to determine two properties of a specimen and a method for determining two properties of a specimen, respectively. The inventions are distinct if either or both of the following can be shown: (1) that the stage supporting the specimen, or (2) that the determining method of the specimen properties consisting of a process step of disposing the specimen upon the stage (MPEP § 806.05(f)). In the instant case, unpatentability of the group I invention would not necessarily imply unpatentability of the group II invention, since the process of determining the specimen properties of the group II invention could be applied using other system materially different than that of the group I invention. For example, the specimen being supported by the stage can be formed in many different methods including the claimed method of disposing the specimen upon the stage. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the fields of search are not coextensive. Hence, separate examination would be required and restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement is traversed (37CFR 1.143) Any inquiry concerning this communication from the Examiner should be directed to *Calvin Lee* at (571) 272-1896 from 7:00 to 17:00 (Monday-Thursday). If attempts to reach the examiner by telephone are unsuccessful, Art Unit 2825's Supervisory Patent Examiner *Matthew Smith* can be reached at (571) 272-1907 Any inquiry relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0596. The fax phones are (703) 872-9318 for regular communications and (703) 872-9319 for After-Final communications.

EL


CARIDAD EVERHART
PRIMARY EXAMINER